

# PATENT COOPERATION TREATY

# PCT

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference 305307018	<b>FOR FURTHER ACTION</b>	See item 4 below
International application No. PCT/AU2004/000347	International filing date ( <i>day/month/year</i> ) 19 March 2004 (19.03.2004)	Priority date ( <i>day/month/year</i> ) 19 March 2003 (19.03.2003) ]
International Patent Classification (IPC) or national classification and IPC 7 G02C 7/08, 9/00, 5/00, 3/02, A61F 9/04		
Applicant MARTIN HOGAN PTY LTD		

1.	This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).																
2.	This REPORT consists of a total of 8 sheets, including this cover sheet.  In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.																
3.	<p>This report contains indications relating to the following items:</p> <table style="width: 100%; border: none;"> <tr> <td style="width: 15%;"><input checked="" type="checkbox"/> Box No. I</td> <td>Basis of the report</td> </tr> <tr> <td><input type="checkbox"/> Box No. II</td> <td>Priority</td> </tr> <tr> <td><input checked="" type="checkbox"/> Box No. III</td> <td>Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</td> </tr> <tr> <td><input checked="" type="checkbox"/> Box No. IV</td> <td>Lack of unity of invention</td> </tr> <tr> <td><input checked="" type="checkbox"/> Box No. V</td> <td>Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</td> </tr> <tr> <td><input checked="" type="checkbox"/> Box No. VI</td> <td>Certain documents cited</td> </tr> <tr> <td><input type="checkbox"/> Box No. VII</td> <td>Certain defects in the international application</td> </tr> <tr> <td><input type="checkbox"/> Box No. VIII</td> <td>Certain observations on the international application</td> </tr> </table>	<input checked="" type="checkbox"/> Box No. I	Basis of the report	<input type="checkbox"/> Box No. II	Priority	<input checked="" type="checkbox"/> Box No. III	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability	<input checked="" type="checkbox"/> Box No. IV	Lack of unity of invention	<input checked="" type="checkbox"/> Box No. V	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement	<input checked="" type="checkbox"/> Box No. VI	Certain documents cited	<input type="checkbox"/> Box No. VII	Certain defects in the international application	<input type="checkbox"/> Box No. VIII	Certain observations on the international application
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4.	The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).																

<p style="text-align: center;">The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland</p> <p>Facsimile No. +41 22 740 14 35</p>	<p>Date of issuance of this report 23 September 2005 (23.09.2005)</p> <p>Authorized officer  Dorothee Mülhausen</p> <p>Telephone No. +41 22 338 87 40</p>
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# PATENT COOPERATION TREATY

REC'D 15 JUN 2004

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From the:  
INTERNATIONAL SEARCHING AUTHORITY

## PCT

### WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

<b>To:</b>  Allens Arthur Robinson Patent & Trademark Attorneys GPO Box 1776Q MELBOURNE VIC 3001			Date of mailing <i>(day/month/year)</i> <div style="text-align: right; font-weight: bold;">- 7 JUN 2004</div>
Applicant's or agent's file reference 305307018		<b>FOR FURTHER ACTION</b> See paragraph 2 below	
International application No. <b>PCT/AU2004/000347</b>	International filing date <i>(day/month/year)</i> 19 March 2004	Priority date <i>(day/month/year)</i> 19 March 2003	
International Patent Classification (IPC) or both national classification and IPC <b>Int. Cl. <sup>7</sup> G 02 C 7/08, 9/00, 5/00, 3/02, A 61 F 9/04</b>			
Applicant  MARTIN HOGAN PTY LTD et al			

**1. This opinion contains indications relating to the following items:**

- |                                     |              |  |
|-------------------------------------|--------------|--|
| <input checked="" type="checkbox"/> | Box No. I    | Basis of the opinion   |
| <input type="checkbox"/>            | Box No. II   | Priority   |
| <input checked="" type="checkbox"/> | Box No. III  | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability   |
| <input checked="" type="checkbox"/> | Box No. IV   | Lack of unity of invention   |
| <input checked="" type="checkbox"/> | Box No. V    | Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input checked="" type="checkbox"/> | Box No. VI   | Certain documents cited  |
| <input type="checkbox"/>            | Box No. VII  | Certain defects in the international application   |
| <input type="checkbox"/>            | Box No. VIII | Certain observations on the international application  |

**2. FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

**3. For further details, see notes to Form PCT/ISA/220.**

Name and mailing address of the IPEA/AU AUSTRALIAN PATENT OFFICE PO BOX 200, WODEN ACT 2606, AUSTRALIA E-mail address: pct@ipaustalia.gov.au Facsimile No. (02) 6285 3929	Authorized Officer  <b>GREG POWELL</b> Telephone No. (02) 6283 2308
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**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

**PCT/AU2004/000347**

**Box No. I      Basis of the opinion**

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.  
☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material  
☐ a sequence listing  
☐ table(s) related to the sequence listing
  - b. format of material  
☐ in written format  
☐ in computer readable form
  - c. time of filing/furnishing  
☐ contained in the international application as filed.  
☐ filed together with the international application in computer readable form.  
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

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**Box No. III**      **Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

☐ the entire international application

☒ claims Nos: **6-23 and 25**

because:

☐ the said international application, or the said claim Nos.

relate to the following subject matter which does not require an international preliminary examination (*specify*):

☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos.  
are so unclear that no meaningful opinion could be formed (*specify*):

☐ the claims, or said claims Nos.  
are so inadequately supported by the description that no meaningful opinion could be formed.

☒ no international search report has been established for said claims Nos. **6-23 and 25**

☐ the nucleotide and/or amino acid sequence listing does not comply with the standard provided for in Annex C of the Administrative Instructions in that:

the written form      ☐ has not been furnished

☐ does not comply with the standard

the computer readable form      ☐ has not been furnished

☐ does not comply with the standard

☐ the tables related to the nucleotide and/or amino acid sequence listing, if in computer readable form only, do not comply with the technical requirements provided for in Annex C-*bis* of the Administrative Instructions.

☐ See Supplemental Box for further details.

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**Box No. IV      Lack of unity of invention**

1. ☒ In response to the invitation (Form PCT/ISA/206) to pay additional fees the applicant has:
- ☐ paid additional fees
- ☐ paid additional fees under protest
- ☒ not paid additional fees
2. ☐ This Authority found that the requirement of unity of invention is not complied with and chose not to invite the applicant to pay additional fees.
3. This Authority considers that the requirement of unity of invention in accordance with Rule 13.1, 13.2 and 13.3 is
- ☐ complied with
- ☒ not complied with for the following reasons:

The international application does not comply with the requirements of unity of invention because it does not relate to an invention or to a group of inventions so linked as to form a general inventive concept. The feature defined in Claim 1 (namely "*a modular eyewear system including magnetic mounting means for releasable magnetic mounting of one or more eyewear elements*") is common to all the claims, however, the search has revealed that the above feature is not novel since it is disclosed in numerous prior art documents

Consequently, the common feature is not a special technical feature within the meaning of PCT Rule 13.2, second sentence, since it makes no contribution over the prior art. Therefore, a posteriori, Claims 1-26 do not satisfy the requirement of unity of invention.

4. Consequently, this opinion has been established in respect of the following parts of the international application:
- ☐ all parts
- ☒ the parts relating to claims Nos. 1-5, 24 and 26

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**Box No. V** Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

**1. Statement**

Novelty (N)	Claims 26	YES
	Claims 1-5, 24	NO
Inventive step (IS)	Claims	YES
	Claims 1-5, 24, 26	NO
Industrial applicability (IA)	Claims 1-5, 24, 26	YES
	Claims	NO

**2. Citations and explanations:**

**NOVELTY (N) Claims 1-5, 24**

**Claims 1 and 5:** The inventions defined in Claims 1 and 5 lack novelty in view of a large number of documents. The art is replete with disclosures of modular eyewear systems that include magnetic mounting means for releasable magnetic mounting of one or more eyewear elements (including frames, lenses, protective shields, optical instruments or illumination devices). For instance, document US 5936700 A discloses detachable auxiliary lenses, mounted by magnetically-fitting pieces over the main spectacles. Similarly, document US 5321442 A discloses replaceable lenses that are magnetically attached to the eyewear frame. Document US 5243366 A discloses an auxiliary magnification lens that is magnetically secured to the main eyeglass lens. Document US 3422449 A discloses eyeglasses with magnetically attached temples. Document EP 1248139 A2 discloses an auxiliary removable set of framed lenses that can be attached to the main eyewear through a magnetic connection of the bridges. Document US 6139141 A discloses a magnetic mounting arrangement for removably attaching auxiliary eyeglasses to an eyeglass frame. Document JP 11-119166 (abstract) discloses a detachable hinge structure of the spectacle frame utilising a magnetic mounting means. Document JP 2003-075783 (abstract) discloses a mounting structure for attaching an optical instrument (visual aid) to a spectacle frame. Document AU 77321/98 A discloses a structure combining a primary spectacle frame with an auxiliary spectacle frame including a connecting port provided with two magnetic members. Thus, the above cited documents clearly disclose all the features of the inventions defined in Claims 1 and 5.

**Claim 2:** The feature added by Claim 2, namely mechanical mounting means for releasable mechanical mounting of eyewear elements (in addition to the magnetic mounting of eyewear elements), lacks novelty in view of a large number of documents. The art is replete with disclosures of a modular eyewear systems that include both magnetic and mechanical mounting means for releasable magnetic and mechanical mounting of one or more eyewear elements. For instance, document US 5936700 A discloses detachable auxiliary lenses, mounted by magnetically-fitting pieces over the main spectacles as well as by mechanical means (hook portion 25, guide projections 13 and guide holes 23). Similarly, document JP 2003-075783 (abstract) discloses mounting a slidable adapter 2, utilising both magnetic and mechanical mounting means.

**Claim 3:** The feature added by Claim 3, namely adjustability of the location of an eyewear element relative to one or more other eyewear elements is not novel in the light of the following prior art documents: US 5321442 A (Figure 9a), US 5243366 A (Figure 9, for instance), JP 2003-075783 (abstract, including the figure depicting a slidable adapter 2). All of the above documents combine the magnetic mounting of eyewear elements with the feature of adjustability of the location of an eyewear element relative to one or more other eyewear elements, achieved by the mechanical mounting means. Consequently, Claim 3 can not be considered novel in the light of US 5321442 A, US 5243366 A, and JP 2003-075783.

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Box No. VI Certain documents cited

1. Certain published documents (Rules 43bis.1 and 70.10)

<u>Application No.</u> <u>Patent No.</u>	<u>Publication date</u> <u>(day/month/year)</u>	<u>Filing date</u> <u>(day/month/year)</u>	<u>Priority date (valid claim)</u> <u>(day/month/year)</u>
US 6611959 B1	2 September 2003	18 May 2002	18 May 2002

This document discloses all of the features of Claims 1-3, 5 and 26.

See Abstract and Figures 1-3.

2. Non-written disclosures (Rules 43bis.1 and 70.9)

<u>Kind of non-written disclosure</u>	<u>Date of non-written disclosure</u> <u>(day/month/year)</u>	<u>Date of written disclosure</u> <u>referring to non-written disclosure</u> <u>(day/month/year)</u>
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INTERNATIONAL SEARCHING AUTHORITY**

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**Supplemental Box**

In case the space in any of the preceding boxes is not sufficient.

Continuation of Box V:

**Claim 4:** The feature added by Claim 4, namely a locating pin and recess is not novel in the light of numerous prior art documents. For example, document US 5936700 A discloses detachable auxiliary lenses, mounted by magnetically-fitting pieces over the main spectacles as well as by the guide projections 13 and guide holes 23. Similarly, document US 5321442 A discloses (in Figure 9a) a locating pin 28 and a few corresponding recesses 30. Document EP 1248139 A2 discloses in Figure 2 a locating hole 12 and a locating pin 22. Consequently, Claim 4 can not be considered to be novel.

**Claim 24:** The feature added by Claim 24, namely a magnetic projection and a cooperating magnetic recess is not novel in the light of numerous prior art documents. For example, document US 5936700 A discloses in Figures 10-11 a magnetically-fitting piece 24 with a projection 13 and a guide hole 23 formed in the centre of the other magnetically-fitting piece 14. Similarly, document US 6139141 A discloses in Figure 12 a magnetic clip 100 for auxiliary eyeglasses, wherein the magnetic clip 100 includes a female part 101 and a male part 102 (a cylindrical rod). Document JP 11-119166 (abstract) discloses a detachable hinge structures for eyeglasses with magnetically attracting recessed parts and projecting parts. Document AU 77321/98 A discloses a magnetic connection for auxiliary spectacle frame that includes a protruding magnetic member 22 and a corresponding recess 15. Consequently, Claim 24 can not be considered to be novel.

**INVENTIVE STEP (IS) Claims 1-5, 24 and 26**

**Claims 1-5 and 24:** as above

**Claim 26:** The feature added by Claim 26, namely combining a modular eyewear system with a protective headwear, does not involve an inventive step in the light of numerous prior art documents. For example, documents US 5289592 A (Figures 1-2) and US 5278999 A (Figures 1-10) disclose a combination of a modular eyewear system with a protective headwear. The invention defined in Claim 26 differs from US 5289592 A and US 5278999 A in utilising magnetic mounting means instead of other types of mounting means (mechanical mounting means). Both types of arrangements are well known in the art and it would be clearly obvious to a person skilled in the art that one could be replaced by the other without materially affecting the way the invention worked. Thus, the differences between the claimed invention and the citations constitute no more than a mere technical equivalent and the claimed invention does not involve an inventive step.